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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,403	01/23/2004	Stephen M. Key	PA2644US	9494
22830	7590	03/28/2005	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			OSELE, MARK A	
			ART UNIT	PAPER NUMBER

1734

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4D

Office Action Summary	Application No.	Applicant(s)	
	10/764,403	KEY, STEPHEN M.	
	Examiner	Art Unit	
	Mark A Osele	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-14, 16, 20, 22-26, 28-30, 33, 35 and 39 is/are rejected.
- 7) ☒ Claim(s) 4-6, 15, 17-19, 21, 27, 31, 32, 34 and 36-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06142004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II in the reply filed on January 3, 2005 is acknowledged. The traversal is on the ground(s) that "temporarily coupling" does not mean "to attach" (in a permanent sense). This is found persuasive and all claims have been rejoined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3, 11-12, 16, 24, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Jespersen. Jespersen teaches that it is known to label a cylindrical object

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with a rotatable label comprising a base affixed directly to the container and a shell having a rotatable portion with a transparent window and top and bottom guide rails separated from the rotatable portion by severable lines of perforation. The top and bottom guide rails are glued to the container and the consumer breaks the lines of perforation to allow rotation of the rotatable portion which affords a view of indicia on the base layer or container itself (column 1, lines 11-31).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 20, 33, and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Coulthard. As shown in paragraph 3 above, Jespersen shows the instantly claimed limitations except for an electrostatic charge to the outer label. Coulthard teaches that the outer, removable layer in a multi-layer display system can be adhered to the inner layer by an electrostatic charge (column 3, lines 11-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the outer label of Jespersen to the inner layer using an electrostatic charge because Coulthard teaches that this allows for easy removal and replacement of an outer indicia bearing layer.

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6. Claims 8-9, 13-14, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Brombacher. As shown in paragraph 3 above, Jespersen shows the instantly claimed limitations except for adhesive between the two labels. Brombacher teaches that three glue dots between the layers of a multi-layer label system allow for repeated removal and replacement of the outer layer from the inner layer (column 3, line 62 to column 4, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the plurality of glue dots of Brombacher to hold the outer label of Jespersen to the inner label because Brombacher teaches that a consumer can easily remove and replace an outer label using this adhesive. Furthermore, it would have been obvious to one of ordinary skill in the art that the adhesive could be applied to either the inside of the outer layer or the outside of the inner layer because both accomplish adhesive between the layers.

7. Claims 10, 25-26, and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Morgan. As shown in paragraph 3 above, Jespersen shows the instantly claimed limitations except for a trailing end of the outer label overlaps a leading end of the outer label. Morgan teaches that the trailing end of the outer label overlaps an adhesive coated leading end of the outer label (column 2, lines 32-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the leading and trailing ends of the label of Jespersen because Morgan teaches that an outer label sealed this way can be easily removed.

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8. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Morgan as applied to claim 25 above, and further in view of Brombacher. Brombacher teaches that three glue dots between the layers of a multi-layer label system allow for repeated removal and replacement of the outer layer from the inner layer (column 3, line 62 to column 4, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the plurality of glue dots of Brombacher to hold the outer label of the references as combined to the inner label because Brombacher teaches that a consumer can easily remove and replace an outer label using this adhesive. Furthermore, it would have been obvious to one of ordinary skill in the art that the adhesive could be applied to either the inside of the outer layer or the outside of the inner layer because both accomplish adhesive between the layers.

Allowable Subject Matter

9. Claims 4-6, 15, 17-19, 21, 27, 31-32, 34, and 36-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art suggests an outer label coupled to an inner label using liquid therebetween, vacuum pressure, or physical pressure to the outer label.


Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kassab, Rawlings et al., and Scott each show multi-layer label systems.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MARK A. OSELE
PRIMARY EXAMINER

March 21, 2005